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Date of Signature and Deposit: October 29, 2004

Nicholas J. Seay

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: James A. Thomson

Date: October 29, 2004

Serial No.: 09/982,637

Group Art Unit: 1632

Filed: 10/18/2001

Examiner: Joseph T. Woitach

For: PRIMATE EMBRYONIC STEM CELLS

Docket No.: 960296.97877

RESPONSE TO ADVISORY ACTION

Commissioner for Patents  
P O Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In further response to the advisory action dated September 22, 2004 in the above-identified application, the applicant responds herewith as follows.

Enclosed with this submission is another Terminal Disclaimer, this disclaimer disclaims the term of this patent which would extend beyond the term of U.S. Patent No. 5,843,780. While it is believed that this Terminal Disclaimer is superfluous, since the term of U.S. Patent No. 6,200,806 has already been disclaimed so as to coincide with the termination of the '780 patent, an additional Terminal Disclaimer is submitted herewith to obviate this ground of rejection.

The applicant also wishes to express thanks to the Examiner Woitach for the interview on October 19, 2004. At that interview comments were presented which are capitulated in the document left with the Examiner at that time to be placed in the file of this application.

It is the further understanding of the applicant that the filing of this document will put the case in condition for allowance and that a notice of allowance will be forthcoming. Accordingly, that is solicited.

Respectfully submitted,

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**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A PRIOR PATENT**

Docket Number (Optional)

960296.97877

In re Application of: James A. Thomson

Application No.: 09/982,637

Filed: 10/18/2001

For: Primate Embryonic Stem Cells

The owner\*, Wisconsin Alumni Research Foundation, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,843,780. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

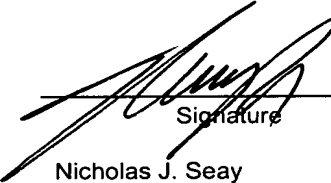
In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record.

  
Signature

10/29/2004

Date

Nicholas J. Seay

Typed or printed name

- ☐ Terminal disclaimer fee under 37 CFR 1.20(d) included.

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\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

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